

## **REMARKS**

### **AMENDMENTS TO THE SPECIFICATION**

5           Page 9, line 12, to page 9, line 14, has been amended to overcome the objection in paragraph 3 of the Office Action. The originally disclosed range of 3 to 7% has been reinstated.

10           The amendment to page 9, line 25, to page 10, line 7, brings the specification into conformity with new claims 100, 110 and 121. Basis for the amendment is the same as stated below for those claims.

### **AMENDMENTS TO THE CLAIMS**

15           The amendments to the claims have been made in the interests of speedy prosecution, and without prejudice to Applicant's right to prosecute other claims, including the canceled claims, in one or more continuing applications.

20           In the claims rejected under 35 USC 102/103, claims 40, 45, 55 and 74 are independent claims. Three of those claims, claims 45, 55 and 74, have been canceled. Claim 40 has been further restricted by replacing the requirement that the SCC polymer is "present in amount such that it thickens the oil" by a requirement that the amount of the SCC polymer is 3-10%, i.e. the concentration range of claim 43, which was not rejected under 35 USC 102/103. Claim 40 has also been amended to remove the  
25           requirement that the composition is at a temperature at which the composition, in the absence of the polymer, is liquid. It is believed to be clear that the omitted limitation (which was added to claim 40 during prosecution in order to help distinguish from Mueller) was not important to the Examiner's decision that claim 43 should not be rejected under 35 USC 102/103. For example, the omitted limitation is not present in  
30           the independent claims which were rejected only on the ground of double patenting. Claim 40 has also been amended to replace the definition of the SCC polymer as a homopolymer by a new definition requiring the SCC polymer to consist of (a) 50-100%

of units derived from a C<sub>12-50</sub>-n-alkyl acrylate and (b) 0-50% of units derived from a non-C<sub>12-50</sub>-n-alkyl acrylate or methacrylate. This new definition of the SCC polymer is similar to the definition in claim 45 (now canceled), but with a further restriction to exclude the possibility that the (a) units are derived from a methacrylate. The new definition of the

5 SCC polymers is prompted by consideration of the newly cited French Patent No. 2,131,111. The English language abstract of the French Patent discloses the addition of certain polymethacrylates to lubricants as VI improvers, thickeners and pour point depressants. The French patent itself discloses that the polymethacrylates are used in amount 0.1-10% by weight, based on the weight of lubricating oil (page 3, lines 10-15);  
10 and that the polymethacrylate may be derived from one or more straight or branched chain alcohols containing 1-18 carbon atoms, e.g. lauryl methacrylate (page 1, lines 35- page 2, line 5, and page 5, Table 1). There is no disclosure of any polymer containing units derived from an acrylate, as required by amended claim 40, or of any composition containing an oil as specified in claim 59 or 120, or of any composition containing water,  
15 as specified in claims 68 and 69, or of any cosmetic composition as specified in claims 77, 80, 81, 100 and 110 or of a method of treating a human substrate as specified in claim 121.

Claim 41, dependent on claim 40, has been amended to remove the reference to  
20 methacrylates and to specify that the n-alkyl group contains 14-22 carbon atoms (for basis see page 6, line 29, of the application is filed). Claims 40 to 43 have been canceled. Claims 46-51, previously dependent on claim 45, have been canceled or made dependent on claim 40. Claim 53, 54 and 56, dependent on canceled claim 55, have been canceled.

25 Claims 61 and 70 (dependent on claims 59 and 69 respectively) have been amended in minor respects so that there are claims specifically directed to compositions in which the SCC polymer has a crystalline melting point of 20 to 80°C (basis on page 9, lines 7-10, of the application as filed).

Claim 59, which is an independent claim rejected only on the ground of provisional double patenting, and claims 66 and 67, which are dependent on claim 59, have been amended to make it clear that mixtures of oils can be used.

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Claims 77 and 78, which were dependent on claim 40 and were rejected only on the ground of provisional double patenting, have been rewritten in independent form, incorporating all the limitations of canceled claim 40 except (a) the limitation that the composition is at a temperature at which the composition, in the absence of the  
10 polymer, is liquid, and (b) the limitation that the SCC polymer is present in amount such that it thickens the oil. It is believed to be clear that the omitted limitations (which were added to claim 40 during prosecution in order to help distinguish from Mueller) were not important to the Examiner's decision that claims 77 and 78 should not be rejected under 35 USC 102/103. For example, these limitations are not present in the independent  
15 claims which were rejected only on the ground of double patenting, i.e. were not rejected under 35 USC 102/103.

New claim 83-91, dependent on claim 77, have been added. The features of these claims find basis on page 6, lines 28-34 (claim 83), page 9, lines 12-14 (claims  
20 84-86), page 6, line 9 (claim 90) and page 9, lines 26-27 (claim 91) of the application as filed.

New claims 92-99, dependent on claim 65, have been added. The features of these claims are the same as the features of claims 68-72.

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New independent claim 100 has been added. Claim 100 is substantially the same as amended claim 77 except that it recites different specific cosmetic compositions. Basis for these specific cosmetic compositions will be found on page 9, line 20-page 10, line 7, of the application as filed ("The invention is particularly useful for  
30 personal care compositions for example..."), taken in conjunction with the disclosures of

the following United States Patents, which are incorporated by reference at page 2, lines 1-7, of the application as filed, in particular the passages specifically noted below.

4,839,166, column 5, lines 10-18

5 "The gelled or thickened cosmetic compositions containing a thickener  
such as defined above may be employed as a shampoo, after-shampoo  
compositions, products for rinsing to be applied before after shampooing,  
before or after dyeing or bleaching, before or after permanent-waving or  
hair straightening, as a hair-setting or blow-drying composition, as a  
restructuring composition, or as a support for permanent-waving or for  
10 dyeing or bleaching hair."

5,192,462, column 6, lines 18-24

" Topical preparations, for example, shampoos, eye makeup formulations,  
cream rinses, lipsticks, lotions, sunscreens, gels, cosmetics in general,  
household cleaning agents, cosmetic emulsions or cosmetic gels,  
15 hairdressing preparations, foam baths and the like. "

5,247,121, column 1, lines 22-24

"... a large number of cosmetic compositions particularly nail varnish."

Column 7, lines 47-49

"... various formulations... such as for example water-in-oil emulsions, oil-  
20 in-water emulsions, sticks, milks etc."

5,736,125, column 5, lines 1-8

"Cosmetic compositions, as used herein, is intended to include oil-based  
cosmetic compositions, including, but not limited to, products for the care  
and hydration of the face and/or body, including the hands, pretanning  
25 lotions, sunscreens, suntan lotions, after-sun lotions, make-up removers,  
lipsticks, mascaras, foundations, perfumed gels or oils, hair-treating oils,  
deodorants, bath oils, and cleansers."

New claims 101-109 are dependent on claim 100. Basis for claims 101-109 is  
30 the same as for claims 83-91.

New independent claim 110 has been added. Claim 110 is substantially the same as claim 78 except that it recites different additives, i.e. "fragrance" has been replaced by "at least one additive selected from sun screen agents, colorants, pigments, silicones, deodorants and antiseptic agents".

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Basis for these additives will be found on page 8, line 31 ("... the temperature at which the composition is to be used.") and page 9, lines 27-34 ("The invention is particularly useful for personal care compositions for example cosmetics, toiletries, and cleansers ...") , of the application as filed, taken in conjunction with the common general knowledge that personal care compositions conventionally contain additives making them suitable for use as cosmetics etc., and the disclosures of the following United States Patents, which are incorporated by reference at page 2, lines 1-7, of the application as filed, in particular the passages specifically noted below.

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4,839,166, column 6, lines 20-22

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"The compositions according to the invention may contain any other ingredient which is usually employed in cosmetics, such as perfumes, colorants, preservatives, sequestering agents, softeners or silicones."

5,192,462, column 12, lines 3-12

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"These topical preparations include the essential compounds of a thickening agent, an active ingredient and the balance being water. Suitable active agents for use in topical preparations include sunscreens, moisturizers, film formers, detergents, emulsifiers, antiseptic agents, conditioning agents, deodorant actives, reducing agents for permanent wave products and the like."

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5,247,121, column 1, lines 38-39

"... a variety of other adjuvants such as, for example, surfactants, polymers, preservatives, colorants, pigments, perfumes and a variety of active compounds."

5,318,995 column 4, lines 8-11

"The cosmetic compositions in accordance with the present invention can contain conventional ingredients (active ingredients, perfumes, preservatives, sunscreen agents and the like)".

5           New claims 111-119 are dependent on claim 110. Basis for claims 111-119 is the same as for claims 83-91.

          New independent claim 120 has been added. Claim 120 is substantially the same as claim 59, except that the oil must comprise a silicone oil (the reference to  
10   silicone oil in claim 59 having been canceled).

          New independent claim 121 has been added. Claim 121 claims a method for treating a substrate selected from human skin, human hair or human nails by applying to the substrate a thickened oil composition comprising an oil and an SCC polymer as  
15   defined (the definition of the SCC polymer being the same as in the claims directed to specific cosmetic compositions), thus cleansing, beautifying, promoting the attractiveness of, or altering the appearance of, the substrate. Basis for claim 121 will be found on page 8, line 31-page 9, line 10 (... the temperature at which the composition is to be used... compositions to be used at 20-25°C... expected  
20   temperature of use) and page 9, lines 27-35 ("The invention is particularly useful for personal care compositions for example cosmetics, toiletries, and cleansers ..."), of the application as filed; taken in conjunction with (1) the common general knowledge that personal care and cosmetic compositions are compositions which are, in use, applied to human skin, human hair or human nails in order to cleanse, beautify, promote the  
25   attractiveness of, or alter the appearance of, the human skin, hair or nails, (2) the statutory definition of the term "cosmetic composition" in the Food, Drug and Cosmetic Act as a composition intended to be "rubbed, poured, sprinkled, or sprayed on, introduced into, or otherwise applied to the human body... for cleansing, beautifying, promoting attractiveness, or altering the appearance", and (3) the disclosures of the  
30   following United States Patents, which are incorporated by reference at page 2, lines 1-7, of the application as filed).

4,839,166, column 6, lines 37-41

"The process for the treatment of hair, of the skin and of the nails consists in applying to them compositions such as defined above..."

column 2, lines 56-58

5 "Another subject of the invention is a process for the treatment of hair or skin making use of this thickener or the composition or containing it."

New claims 122-129 are dependent on claim 101. Basis for claim 122 is on page 10, lines 14-15, of the application as filed. Basis for claim 123 is on page 9, line 26.

10 Basis for claim 124 is on page 8, lines 30-31. Basis for claim 125 is on page 9, line 10. Basis for claim 126 is on page 9, line 5. Basis for claim 127 is on page 8, lines 30-31 the same as for claims 67-72. Claims 128 and 129 define the SCC polymer in the same way as claims 63 and 64.

15 After making the requested amendments, the independent claims fall into the following categories: --

(a) Claim 40, which requires that the SCC polymer is present in amount 3-10% by weight, and consists of 50-100% of units derived from at least one n-alkyl acrylate in which the n-alkyl group contains 12-50 carbon atoms and  
20 0-50% of units derived from an alkyl acrylate or methacrylate in which the alkyl group is not an n-alkyl group containing 12-50 carbon atoms;

(b) Claims 59 and 120, which require that the oil comprises one or more of specified oils;

(c) Claims 68 and 69, which require that the composition contains water;

25 (d) Claims 77, 80 and 100, which require that the composition is a specified type of cosmetic composition;

(e) Claims 78, 81 and 110, which require that the composition contains a specified additive; and

(f) Claim 121, which is directed to a method of treating a human substrate.

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It is believed to be clear that method Claim 121 can properly be added at this stage of prosecution without giving rise to a restriction requirement. Thus, it is believed that examination of all the claims now in the application will not place a serious burden on the Examiner; in particular, it is believed that no additional search will be required, having regard to the fact that the application previously contained a variety of claims directed to cosmetic compositions.

## THE OBJECTION AND REJECTIONS

### The Objections under 37 CFR 1.75.

Each of claims 77 and 80 has been rewritten in independent form, as recommended by the Examiner. Claims 79 and 82 have been canceled. It is believed to be clear, therefore, that the objections should be withdrawn.

### The Objection under 35 USC 132

The passage in question has been amended, and it is believed to be clear that the objections should now be withdrawn

### The Rejection under 35 USC 112

Claim 54 has been canceled, and it is believed to be clear that this rejection should now be withdrawn.

### The Provisional Double Patenting Rejection

A Terminal Disclaimer is filed herewith to overcome the provisional double patenting rejection.



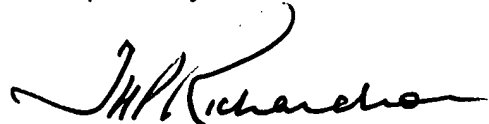
The Rejections under 35 U.S.C. 102 and 35 U.S.C. 103

Applicants respectfully traverse the rejection of claims 40-42, 45-50, 53-56 and 74-76 under 35 U.S.C. 102 as anticipated by Mueller (U.S. Patent No. 5,281,329),, and under 35 USC 103 as unpatentable over, Mueller in view of McCoy et al and Paboucek, and further in view of Franck, and even further in view of Norbury, insofar as those rejections are applicable to the amended claims. As noted above, claim 40 has been amended by including the feature of claim 43, which was not rejected on this ground, and the other rejected claims have either been canceled or made dependent on amended claim 40.

**CONCLUSION**

It is believed that this application is now in condition for allowance. If, however, there are any outstanding issues that could usefully be discussed by telephone, the Examiner is asked to call the undersigned.

Respectfully submitted



T. H. P. Richardson, Reg. No.28,805

Tel No. 650 854 630

